



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

48

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,792	12/13/2001	San-Yup Lee	HYLEE60.001APC	5798
20995 7590 05/20/2005 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			EXAMINER DEVI, SARVAMANGALA J N	
			ART UNIT	PAPER NUMBER
			1645	
DATE MAILED: 05/20/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/009,792	Applicant(s) LEE ET AL.	
	Examiner S. Devi, Ph.D.	Art Unit 1645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 ~~is/are~~ are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 2 and 7-10 ~~is/are~~ are allowed.
- 6) ☒ Claim(s) 3-6 and 11-13 ~~is/are~~ are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

RESPONSE TO APPLICANTS' AMENDMENT

Applicants' Amendment

- 1) Acknowledgment is made of Applicants' amendment filed 02/28/05 in response to the non-final Office Action mailed 11/30/04. With this, Applicants have amended the specification.

Status of Claims

- 3) Claims 1-6, 8, 9 and 12 have been amended via the amendment filed 02/08/05.
Claims 1-13 are pending and are under examination.

Prior Citation of Title 35 Sections

- 4) The text of those sections of Title 35 U.S. Code not included in this action can be found in a prior Office Action.

Prior Citation of References

- 5) The references cited or used as prior art in support of one or more rejections in the instant Office Action and not included on an attached form PTO-892 or form PTO-1449 have been previously cited and made of record.

Priority Document

- 6) A certified copy of the foreign priority document, 2000/17052 filed 03/31/00 in Republic of Korea, is yet to be submitted to the Office in the instant application. Applicants assure the Office that a certified copy of the priority document would be submitted in due course.

Objection(s) Withdrawn

- 7) The objection to the specification made in paragraph 7 of the Office Action mailed 11/30/04 is withdrawn in light of Applicants' amendment to the specification.
- 8) The objection to claim 8 made in paragraph 10(a) of the Office Action mailed 11/30/04 is withdrawn in light of Applicants' amendment to the claim.
- 9) The objection to claim 6 made in paragraph 10(b) of the Office Action mailed 11/30/04 is withdrawn in light of Applicants' amendment to the claim.

Rejection(s) Withdrawn

- 10) The rejection of claim 2 made in paragraph 9(a) of the Office Action mailed 11/30/04 under

35 U.S.C. § 112, second paragraph, as being indefinite, is withdrawn in light of Applicants' amendment to the claim.

11) The rejection of claim 2 made in paragraph 9(b) of the Office Action mailed 11/30/04 under 35 U.S.C. § 112, second paragraph, as being indefinite, is withdrawn in light of Applicants' amendment to the claim.

12) The rejection of claim 2 made in paragraph 9(c) of the Office Action mailed 11/30/04 under 35 U.S.C. § 112, second paragraph, as being indefinite, is withdrawn in light of Applicants' amendment to the claim.

13) The rejection of claim 4 made in paragraph 9(d) of the Office Action mailed 11/30/04 under 35 U.S.C. § 112, second paragraph, as being indefinite, is withdrawn in light of Applicants' amendment to the claim.

14) The rejection of claim 5 made in paragraph 9(e) of the Office Action mailed 11/30/04 under 35 U.S.C. § 112, second paragraph, as being indefinite, is withdrawn in light of Applicants' amendment to the claim.

15) The rejection of claim 3 made in paragraph 9(f) of the Office Action mailed 11/30/04 under 35 U.S.C. § 112, second paragraph, as being indefinite, is withdrawn in light of Applicants' amendment to the claim.

16) The rejection of claims 3 and 12 made in paragraph 9(g) of the Office Action mailed 11/30/04 under 35 U.S.C. § 112, second paragraph, as being indefinite, is withdrawn in light of Applicants' amendment to the claims.

17) The rejection of claim 8 made in paragraph 9(h) of the Office Action mailed 11/30/04 under 35 U.S.C. § 112, second paragraph, as being indefinite, is withdrawn in light of Applicants' amendment to the claim.

18) The rejection of claim 9 made in paragraph 9(i) of the Office Action mailed 11/30/04 under 35 U.S.C. § 112, second paragraph, as being indefinite, is withdrawn in light of Applicants' amendment to the claim.

19) The rejection of claim 12 made in paragraph 9(j) of the Office Action mailed 11/30/04 under 35 U.S.C. § 112, second paragraph, as being indefinite, is withdrawn in light of Applicants'

amendment to the claim.

20) The rejection of claim 6 made in paragraph 9(k) of the Office Action mailed 11/30/04 under 35 U.S.C. § 112, second paragraph, as being indefinite, is withdrawn in light of Applicants' amendment to the claim.

21) The rejection of claim 1 made in paragraph 9(l) of the Office Action mailed 11/30/04 under 35 U.S.C. § 112, second paragraph, as being indefinite, is withdrawn in light of Applicants' amendment to the claim.

22) The rejection of claims 2, 4-6 and 8-13 made in paragraph 9(m) of the Office Action mailed 11/30/04 under 35 U.S.C. § 112, second paragraph, as being indefinite, is withdrawn in light of Applicants' amendment to the base claim.

Rejection(s) Maintained

23) The rejection of claim 13 made in paragraph 9(j) of the Office Action mailed 11/30/04 under 35 U.S.C. § 112, second paragraph, as being indefinite, is maintained for reasons set forth therein.

New Rejection(s) Based on Applicants' Amendment

The following new rejection is necessitated by Applicants' amendments to the claim(s).

Rejection(s) under 35 U.S.C § 112, First Paragraph (New Matter)

24) Claim 3 and those dependent therefrom are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

Independent claim 3, as amended, now includes the limitation: 'lacking its native signal sequence'. Applicants point to lines 4-15 of page 10 of the specification as providing the descriptive support for the new limitations. However, there appears to be no support in this part of the specification for the limitation: lacking its 'native' signal sequence. Therefore, the limitations in the claims are considered to be new matter. *In re Rasmussen*, 650 F2d 1212 (CCPA, 1981). New matter includes not only the addition of wholly unsupported subject matter but also, adding specific percentages or compounds after a broader original disclosure, or even omission of a step from a method. See M.P.E.P 608.04 to 608.04(c).

Applicants are respectfully requested to remove the new matter from the claim(s), point to specific pages and line numbers in the originally filed specification where support for such a recitation can be found, or replace the phrase with --with its signal sequence removed--.

Remarks

25) Claims 3-6 and 11-13 stand rejected. Claims 1, 2 and 7-10 are allowable.

26) Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. **THIS ACTION IS MADE FINAL.** Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

27) Papers related to this application may be submitted to Group 1600, AU 1645 by facsimile transmission. Papers should be transmitted via the PTO Fax Center which receives transmissions 24 hours a day and 7 days a week. The transmission of such papers by facsimile must conform with the notice published in the Official Gazette, 1096 OG 30, November 15, 1989. The Fax number for submission of after-final amendments is (703) 872-9306.

28) Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAG or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.Mov>. Should you have questions on access to the Private PAA system, contact the Electronic to S. Devi, Ph.D., whose telephone number is (571) 272-0854. A message may be left on the Examiner's voice mail system. The Examiner can normally be reached on Monday to Friday from 7.15 a.m. to 4.15 p.m. except one day each bi-week, which would be disclosed on the Examiner's voice mail system.

Serial No. 10/009,792

Art Unit: 1645

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Lynette Smith, can be reached on (571) 272-0864.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the Examiner should be directed the Group receptionist whose telephone number is (571) 272-1600.

May, 2005


S. DEVI, PH.D.
PRIMARY EXAMINER